



REMARKS

Applicant gratefully acknowledges withdrawal of the 35 USC § 112 rejections.

Discussion of the 35 U.S.C. § 102 Rejections

Applicant gratefully acknowledges withdrawal of the 35 USC § 102(b) rejections in view of Inouye.

Claims 1, 2, 9-19, 21, 24, and 25 are rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Noonberg *et al.* (U.S. Patent No. 5,624,803) ("Noonberg II"). This rejection is respectfully traversed.

Applicant respectfully submits that Noonberg II is not prior art to the instant invention. The instant application has a priority date of August 19, 1994. Noonberg II issued from a continuation-in-part application filed on October 13, 1994 that claimed priority to patent application serial No. 08/138,666 ("Noonberg I"), which was filed on October 13, 1993. Since Noonberg II was filed subsequent to the priority date of the present application, only disclosures found in Noonberg I can anticipate the present claims.

However, Applicant submits that Noonberg I does not anticipate claims 1, 2, 9-19, 21, 24, and 25. The present claims are directed to a transcribed non-naturally occurring RNA molecule, comprising a desired RNA portion, wherein said desired RNA portion is present between a 3' region and a 5' region, wherein said 3' region and said 5' region form an intramolecular stem with each other comprising at least 8 base pairs. Under 35 U.S.C. § 102(b), a claim is anticipated only if each and every element as set forth in the claim is found in a single art reference.

Verdegaal Bros. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 10533 (Fed. Cir. 1987);

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M.P.E.P. § 2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); M.P.E.P. § 2131.

Noonberg I does not anticipate claims 1, 2, 9-19, 21, 24, and 25 because it fails to teach or suggest a transcribed non-naturally occurring RNA molecule, comprising a desired RNA portion, wherein said desired RNA portion is present between a 3' region and a 5' region, wherein said 3' region and said 5' region form an intramolecular stem with each other comprising at least 8 base pairs. In contrast to the presently claimed molecules, Noonberg I describes a molecule with "self-complementary ends" where the oligonucleotide forms "small double-stranded hairpin loops" (page 9, first paragraph, lines 12-14) at each end. These molecules are shown in Figure 2 as "sample transcript". As described and shown in Figure 2, the structure disclosed in Noonberg I does not have a desired RNA portion present between a 3' region and a 5' region that form an intramolecular stem *with each other*, as required by the present claims. Instead, the Noonberg I structure contains a binding region present between a 5' region that forms an intramolecular stem *with itself* and a 3' region that forms an intramolecular stem *with itself*. The resulting structure containing two distinct stem loops, one at the 3' end and the other at the 5' end, with the binding region in-between the two loops is very different from the presently claimed structure having a desired region located between a 5' region and 3' region that forms a *single* intramolecular stem with each other, i.e., resulting in the desired portion being located within the stem loop region. The instantly claimed invention is therefore distinct from the RNA molecules described in Noonberg I.



Further, any additional disclosure in Noonberg II, as compared to Noonberg I, is not prior art to the present claimed invention. For example, as the Office Action notes on page 4, Noonberg II discloses an oligonucleotide that has “a 5’ and 3’ self-complementary hairpin, creating a lariat-like structure with the oligonucleotide within the loop” (see, for example column 18, lines 50-53). Without conceding that such a lariat-like structure would anticipate the present claims, Applicant respectfully points out that the lariat structure described in the Office Action is only found in Noonberg II, and is not taught or even suggested in Noonberg I, the priority document. Thus, Noonberg II cannot be cited as anticipating the present invention and, therefore, Applicant respectfully requests that the 35 U.S.C. § 102(e) rejection be withdrawn.

Conclusion

The application is considered to be in good and proper form for allowance and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone call would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney.

Respectfully Submitted,
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Date: June 16, 2003